

Remarks

Applicant has reviewed the Office Action dated as mailed January 23, 2006, and the documents cited therewith. After the above amendments have been made, the present application contains claims 1-4, 6-17, 19-32 and 34. Claims 1, 16, 23 and 30 have been amended. The title has been amended to better describe the invention. No new matter has been added.

Claim Rejections under 35 U.S.C. §102

Claims 1-2, 8 10, 11, 13-14, 16-17, 22-27 and 30-31 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, Jr. et al. (U.S. Patent No. 5,999,816; hereinafter Tiedemann). These rejections are respectfully traversed.

Turning initially to the rejection of independent claim 1 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, claim 1 has been amended to recite:

“receiving a first quality indicator for only a single channel from a current communications system;
remaining in communication with the current system;
receiving a second quality indicator for only the same channel after a predetermined time period in response to the first quality indicator being below a predetermined thresh hold value; ...”

In contrast, the Office Action referred to column 3, line 47 through column 10, line 4 and Figure 5 of Tiedemann for the feature of the second quality indicator being met by going through the feedback loop in Figure 5 when the received total pilot energy E_C/I_O does not exceed a MIN _TOT_ PILOT [i.e. the predetermined threshold value at step 60 in Figure 5], the process continues to monitor viable pilots until a quality indicator exceeds a predetermined threshold value and leading to a successful hard handoff at step 62 in Figure 5 of Tiedemann. As clearly shown in Figure 5 of Tiedemann, if the received E_C/I_O exceeds the MIN_TOT_PILOT the method will loop back through either block 65 or block 69 where Tiedemann teaches that the communications device returns to the original system. In block 58 of Figure 5, Tiedemann teaches that the mobile tunes to a new frequency and pilots on a neighboring system according to an Other Frequency Neighbor List Message (OFNLM). Accordingly, Tiedemann teaches away from the communication device remaining in communication with the current system as required by the present invention as recited in amended claim 1.

Additionally, in column 9 beginning at line 46 Tiedemann recites:

“In block 60, the mobile station measures a pilot energy, the sum of the energy of all pilots in the Active Set...”

In column 3, lines 55 and 56 Tiedemann defines the Active Set as the neighboring base stations. Accordingly, Tiedemann teaches summing the energy for all pilots from neighboring base stations. Tiedemann does not teach or suggest receiving a first quality indicator for only a single channel and receiving a second quality indicator for only the same channel as required by the present invention as recited in amended claim 1.

For all of the reasons discussed above, Applicant respectfully submits that claim 1, as amended, is patentably distinguishable over Tiedemann, and reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of independent claim 1 is respectfully requested.

With regard to the rejection of independent claims 16 and 30 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, claims 16 and 30 have been amended to recite similar features to independent claim 1. Therefore, Applicant respectfully submits that the claims 16 and 30 are also patentably distinguishable over Tiedemann for the same reasons as discussed with respect to claim 1. Reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of claims 16 and 13 is, therefore, also respectfully solicited.

Turning now to the rejection of claims 2, 8, 10, 11 and 13-14 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, these claims contain additional features which further patentably distinguish over Tiedemann. For example, claim 13 recites “scanning any channels in the channel scan list comprises performing a micro scan of any channels on a grey zone channel list” and claim 14 recites “receiving a received signal strength indication (RSSI) for a channel in the grey zone channel list...” Applicant respectfully submits that Tiedemann shows no recognition of the problem solved by the present invention with respect to the grey zone condition as described in the present application. Additionally, Tiedemann does not teach or suggest a grey zone channel list, performing a micro scan of any channels on a grey zone channel list, or receiving a received signal strength indication for a channel in the grey zone channel list as provided by the present invention as recited in claims 13 and 14.

Further, claims 2, 8, 10, 11, and 13-14 depend either directly or indirectly from independent claim 1. As a result of this dependency, these claims contain all of the features of

independent claim 1. Therefore, Applicant respectfully submits that claims 2, 8, 10, 11 and 13-14 are also patentably distinguishable over Tiedemann, and reconsideration and withdrawal of the Section 102 rejection of these claims is respectfully requested.

With respect to the rejection of claims 17 and 22 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, claims 17 and 22 depend directly from independent claim 16. Because of that dependency, these claims contain all of the features of independent claim 16. Therefore, Applicant respectfully submits that claims 17 and 22 are also patentably distinguishable over Tiedemann, and reconsideration and withdrawal of the Section 102 rejection of these claims is respectfully solicited.

Turning now to the rejection of independent claim 23 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, claim 23 as been amended to recite:

“a receiver to receive a first quality indicator for only a single channel and a second quality indicator for only the same channel after a predetermined period of time in response to the first quality indicator being below a predetermined threshold value, wherein the first and second quality indicators are received from a current communications system and the communication device remains in communication with the current communication system during the predetermined time period;”

In contrast, as previously discussed with respect to the rejection of independent claim 1, Tiedemann teaches in Figure-5 that the communication device returns to the original system in response to a received E_C/I_0 not exceeding a MIN_TOT_PILOT. Tiedemann does not teach or suggest that the communication device remains in communication with the current communication system during the predetermined period of time between receipt of a first quality indicator and a second quality indicator. Additionally, as discussed with respect to independent claim 1 Tiedemann teaches determining the sum of the energy of all pilots in an Active Set, wherein the Active Set is the neighboring base stations. Tiedemann does not teach or suggest receiving a first quality indicator for only a single channel and second quality indicator for only the same channel as required by the present invention as recited in independent claim 23. Therefore, for all of these reasons, claim 23 is submitted to be patentably distinguishable over Tiedemann, and reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of claim 23 is respectfully requested.

Turning now to the rejection of claims 24, 25, 26 and 27, these claims contain additional features which further patentably distinguish over Tiedemann. Claim 26 recites “a memory coupled to the microprocessor, wherein the memory includes a grey zone channel list.” As previously discussed, Tiedemann shows no recognition for the problem solved by the present invention with respect to a Grey Zone condition as described in the present application, nor does Tiedemann teach or suggest a grey zone channel list to avoid this problem.

Claim 27 recites “wherein the channel scan list comprises a preferred a roaming list.” The Office Action asserted that the extended list of base stations presented to the mobile meets a preferred roaming list, since Tiedemann teaches the list of base stations on the extended list constitutes base stations to mobile station may be able to acquire. Applicant respectfully disagrees. Just because a base station may be on a list of base stations that a mobile station may be able to acquire does not mean that the base station would also be on a preferred roaming list as defined in the present application. As described in paragraph 0014 of the present application, a preferred roaming list is a database of systems and channels in different geographical areas that are preferred systems and channels for the communication device to acquire and communicate over because of more favorable roaming charges, fees or the like. Applicant respectfully submits that Tiedemann does not teach or suggest a preferred roaming list as part of a channel scan list as provided by the present invention as recited in claim 27.

Additionally, claims 24-27 depend directly from independent claim 23, and by virtue of that dependency contain all of the features of independent claim 23. Therefore, claims 24-27 are also submitted to be patentably distinguishable over Tiedemann, and reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of claims 24-27 is respectfully requested.

Regarding the rejection of claim 31 under 35 U.S.C. § 102 (b) as being anticipated by Tiedemann, claim 31 depends directly from independent claim 30, and as a result of this dependency, contains all of the features of independent claim 30. As previously discussed, independent claim 30 has been amended to patentably distinguish over Tiedemann; accordingly, claim 31 is also submitted to be patentably distinguishable over Tiedemann for all of the reasons discussed with respect to claim 30, and reconsideration and withdrawal of the Section 102 rejection of claim 31 is respectfully solicited.

Claim Rejections under 35 U.S.C. §103

Claim 15 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tiedemann as applied to claim 1, and further in view of Shah (US Patent No. 6,047,071, hereinafter Shah). Claim 15 depends directly from independent claim 1, and because of that dependency contains all of the features of independent claim 1. Shah teaches a network-initiated change of mobile phone parameters and adds nothing to the teachings of Tiedemann so as to render independent claim 1 unpatentable. Therefore, Applicant respectfully submits that claim 15 is patentably distinguishable over Tiedemann and Shah, whether considered individually or combined, and reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of claim 15 is respectfully requested.

Claims 3-4, 21 and 32 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tiedemann as applied to claims 1, 16, 23 and 30, and further in view of Ostberg et al. (U.S. Publication No. 2004/0203839 A1, hereinafter Ostberg). Applicant respectfully submits that this rejection under 35 U.S.C. § 103 does not follow the M.P.E.P. § 706.02 (j) which states:

“after indicating the rejection is under 35 U.S.C. § 103 the examiner should set forth in the Office Action:...(b) the difference or differences in the claim over the applied reference(s), (C) a proposed modification of the applied reference(s) necessary to arrive at the claims subject matter, and (D) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification... the teaching or suggest to make the claim, combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.” *In re Vaeck*, 947 F2d 488, 20 USPQ2d 1438(Fed.Cir.1991).

As discussed in detail below, Applicant respectfully submits that there is no teaching or suggestion in Tiedemann and Ostberg that their teachings may be combined so as to provide the present invention as recited in the claims and such motivation only comes from applicant’s disclosure. This approach constitutes impermissible hindsight and must be avoided. Even if it were proper to combine Tiedemann and Ostberg, they still would not provide the present invention as recited in claims 3-4, 21 and 32.

Turning initially to claim 3, claim 3 recites “wherein scanning any channels in the channel scan list comprises skipping any channels on a grey zone channel list.” Applicant

respectfully submits that neither Tiedemann nor Ostberg show any recognition for the problem solved by the present invention with respect to the grey zone condition, nor do either Tiedemann or Ostberg teach or suggest a grey zone channel list or skipping any channels on the grey zone channel list as provided by the present invention as recited in claim 3.

Additionally, claim 3 depends directly from independent claim 1 and by virtue of that dependency, contains all of the features of independent claim 1. Claim 1 has been amended to patentably distinguish over Tiedemann, as previously discussed. Applicant respectfully submits that Ostberg adds nothing to the teachings of Tiedemann so as to render independent claim 1 unpatentable. Accordingly, for all of these reasons, claim 3 is submitted to be patentably distinguishable over Tiedemann and Ostberg, whether considered individually or combined, and reconsideration and withdrawal of the Section 103 rejection of claim 3 is respectfully solicited.

Regarding the 35 U.S.C. § 103 rejection of claims 21 and 32 as being unpatentable over Tiedemann in view of Ostberg, these claims contain features similar to claim 3. Additionally, claim 21 depends directly from independent claim 16 and claim 32 depends directly from independent claim 30. As discussed hereinabove, claims 16 and 30 have been amended to patentably distinguish over Tiedemann, and Applicant respectfully submits that Ostberg adds nothing to the teachings of Tiedemann so as to render either of claims 16 and 30 unpatentable. Therefore, claims 21 and 32 are also submitted to be patentably distinguishable over Tiedemann and Ostberg, whether considered individually or combined, and reconsideration and withdrawal of the Section 103 rejection of claims 21 and 32 is respectfully solicited.

Claims 6, 12, 19-20 and 34 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tiedemann as applied to claims 1, 16, 23 and 30, and further in view of Kamel et al. (U.S. Patent No. 6,496,531, hereinafter Kamel). Applicant respectfully submits that this rejection under 35 U.S.C. § 103 does not follow the M.P.E.P. § 706.02 (j) as recited above. Applicants further respectfully submit that there is no teaching or suggestion in Tiedemann and Kamel that their teachings may be combined so as to provide the present invention as recited in the claims and such motivation only comes from Applicant's disclosure. Even if it were proper to combine Tiedemann and Kamel, their teachings would still not provide the present invention as recited in the claims. Neither Tiedemann nor Kamel recognize the problem solved by the present invention with respect to the grey zone condition. Additionally neither Tiedemann nor Kamel teach or

suggest adding a channel to a grey zone channel list in response to a second quality indicator signal being below a predetermined threshold value or removing the channel from the grey zone channel list after the channel has been in the grey zone channel list for a predetermined period of time as respectively recited in the claims 6, 12, 19-20 and 34.

Furthermore, claims 6 and 12 depend directly from independent claim 1; claims 19 and 20 depend either directly or indirectly from independent claim 16; and claim 34 depends directly from independent claim 30. As previously described, independent claims 1, 16 and 30 have been amended to patentably distinguish over Tiedemann. Kamel adds nothing to the teachings of Tiedemann so as to render these claims unpatentable. Therefore, for all of these reasons, claims 6, 12, 19-20 and 34 are submitted to be patentably distinguishable over Tiedemann and Kamel, whether considered individually or combined, and reconsideration and withdrawal of the 35 U.S.C. § 103 (a) rejection of these claims is respectfully solicited.

Claim 7 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tiedemann as applied to claim 1, and further in view of Labun et al. (U.S. Patent No. 6,842,621, hereinafter Labun). Applicant respectfully submits that there is no teaching or suggestion in either Tiedemann or Labun that their teachings may be combined so as to provide the present invention as recited in the claims of the present application and such motivation merely comes from Applicant's disclosure which is improper hindsight. Labun may teach a hysteresis timer, but the purpose of Labun's hysteresis timer is totally different from that of the present invention as recited in claim 7. The hysteresis timer in Labun is to prevent a ping-pong handover effect as indicated in the Office Action on page 13 and not to time between receiving a first quality indicator and a second quality indicator as provided by the present invention as recited in claim 7. Labun does not teach or suggest starting a hysteresis time in response to the first quality indicator being below the predetermined threshold value and receiving a second quality indicator after the hysteresis timer expires as recited in claim 7. Additionally, claim 7 depends directly from independent claim 1. Claim 1 has been amended to patentably distinguish over Tiedemann and Applicant respectfully submits that Labun adds nothing to the teachings of Tiedemann so as to render independent claim 1 unpatentable. For all of these reasons, claim 7 is submitted to be patentably distinguishable over Tiedemann and Labun, whether considered individually or

combined, and reconsideration and withdrawal of the Section 103 rejection of claim 7 is respectfully requested.

Claims 9 and 28-29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tiedemann as applied to claims 1 and 23, and further in view of Douthitt et al. (U.S. Patent No. 5,524,280, hereinafter Douthitt). Applicant respectfully submits that this rejection under 35 U.S.C. § 103 is improper under M.P.E.P. § 706.02 (j) in that there is no teaching or suggestion in Tiedemann or Douthitt that their teachings may be combined so to provide the present invention as recited in the claims and such teaching only comes from applicant's disclosure. Even if proper to combine Tiedemann and Douthitt they still would not provide the present invention as recited in the claims. Claims 9 and 28-29 recite features which patentably distinguish over Tiedemann and Douthitt whether considered individually or combined. Additionally, claim 9 depends directly from independent claim 1 and claims 28-29 depend directly from independent claim 23. Independent claims 1 and 23 have been amended to patentably distinguish over Tiedemann, as discussed above. Applicant respectfully submits that Douthitt adds nothing to the teachings of Tiedemann so as to render independent claim 1 or 23 unpatentable. Accordingly, claims 9 and 28-29 are submitted to be patentably distinguishable over Tiedemann and Douthitt, whether considered individually or combined, and reconsideration and withdrawal of the Section 103 rejection of claim 9 and 28-29 is respectfully requested.

Conclusion

Applicant respectfully requests entry of this amendment under Rule 116 in that this amendment renders all of the claims in the present application in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims at the earliest possible date are respectfully requested.

In the event that the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

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